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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,971	05/15/2001	Takao Omachi	NEC N01268	1601

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EXAMINER

MANNING, JOHN

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,971	OMACHI, TAKAO	
	Examiner	Art Unit	
	John Manning	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Supplemental Note

1. The examiner of record has changed.

Response to Arguments

2. Applicant's arguments filed June 6, 2006 have been fully considered but they are not persuasive. Applicant argues, "...the teaching of using the same channel frequency to display selected commercial messages missing from Wilkins also is missing from Dedrick." The examiner respectfully disagrees. *Wilkins* discloses individual channels to deliver a plurality of commercials. Looking to Figure 3 (also see Figures 4-7), channel 2 will carry a plurality of commercials over a time period. Following program segment 340, will be another commercial on channel 2. Channels 2, 4 and 5 will each have a plurality of commercials transmitter over the same channel frequency (looking at either channel 2, 4 or 5) over a time period. Furthermore, it is well known in the art to present multiple commercial within a time slot. Channels 1, 4 and 5, are multiple channels, which are inherently different frequencies. These channel carry audio/voice information at least during the commercial segment. At any given single point in time only one channel is being displayed to the user.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3, 7, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wilkins* (US Pat. No. 5,466,919) in view of *Dedrick*. (US Pat. No. 5,717,923).

As to claim 1, *Wilkins* discloses a system for transmitting and receiving commercial messages ("CM") and/or advertisements comprising a broadcast station terminal, which transmits a plurality of compressed audiovisual signals (i.e., scaled-down and synthesized images/voices). The system also comprises a transmitting device used to modulate said audiovisual signal and a receiving terminal, which automatically selects a commercial message based upon a subscriber's profile. Lastly, the transmitted CM's contain identification information, such as that described at Column 11, Lines 27-38. (Abstract; Col. 2, Ln. 44-53; Col. 8, Ln. 42-61; Col. 9, Ln. 13-19; Col. 6, Ln. 43-67; col. 17, Ln. 14-22; Col. 9, Ln. 32-40; Col. 10, Ln. 1-11; Col. 11, Ln. 27-38).

But, *Wilkins* fails to disclose a viewer attribute setting device, which is used by the viewer to set his or her attributes (e.g., age and sex) in advance. However, within the same field of endeavor, *Dedrick* discloses a similar system having a graphical user interface whereby the user is allowed to set personal attributes (i.e., age, sex, and other preferences) in advance. (Abstract; Col. 3, Ln. 37-Col. 4, Ln. 10). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Wilkins* and *Dedrick*, thereby providing the user with more control and/or privacy over his or her profile attributes.

Claim 13 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

Claim 3 recites the system of claim 1, further comprising limitations too numerous to recite herein. (refer to claim sheet). As to claim 3, *Wilkins* further discloses transmitting digital CM/identification information within the vertical blanking interval ("VBI"). (Col. 2, Ln. 31-40; Col. 6, Ln. 49-58; Col. 8, Ln. 43-55). Moreover, in digital transmission, it is inherent to transmit data in packets.

Regarding the limitation addressing analog transmission, the Examiner takes Official Notice that, at the time of Applicant's invention, it was notoriously well-known in the art to utilize analog transmission. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of applicant's invention to further modify the combined systems of *Wilkins* and *Dedrick* to also include analog transmission, thereby enabling the system to be available to a broader range of subscribers. *[Note: At Col. 6, Ln. 49-58, one could argue that analog transmission is discussed because Wilkins specifically states the system also includes "future digital video systems." Therefore, one could infer the system, in general, is addressing analog transmissions.]*

Claim 15 corresponds to the system claim 3. Thus, it is analyzed and rejected as previously discussed.

As to Claim 7, *Wilkins* further teaches the system can also be controlled via a user's manual input. (Col. 10, Ln. 26-40). To clarify the Examiner's interpretation, *Wilkins* teaches the viewed channels (which contain commercial messages (Col. 9, Ln. 20-21)) can be determined by the viewer's channel selection. The remainder of Claim 7's limitations are encompassed within Claim 1. Accordingly, the combined systems of *Wilkins* and *Dedrick* disclose all limitations of claim 7.

[Note: Although not relied upon to reject Claim 7, Hendricks et al, US Pat. No. 5,990,927, disclose a set top terminal which allows the user to manually select commercials. (Col. 22, Ln. 29-33).]

5. Claims 2, 4, 6, 8, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wilkins* in view of *Dedrick*, as discussed under Claim 1, and further in view of *Wachob*. (US Pat. No. 5,155,591).

Claim 2 recites the system of claim 1, and further limitations too numerous to recite herein (refer to claim sheet). As discussed above, the combined systems of *Wilkins* and *Dedrick* render obvious all limitations of Claim 1, but fail to specifically disclose those of Claim 2. However, within the same field of endeavor, *Wachob* discloses a similar system wherein the receiving terminal (i.e., set top box) transmits CM/Identification information to the headend (i.e., advertising terminal) in order to provide statistical data. (Abstract; Col. 1, Ln. 39-55; Col. 2, Ln. 43-49; Col. 8, Ln. 17-66; Col. 10, Ln. 27-43). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of applicant's invention to combine the systems of *Wilkins*, *Dedrick*, and *Wachob* in order to provide a system which maintains real-time records of demographic characteristics of subscribers and the programs they watch.

Claim 8 corresponds to Claim 2. Thus, it is analyzed and rejected as previously discussed.

As to claim 4, *Wilkins* further discloses the system is capable of switching between alternate commercials (i.e., cutting) and capable of two-way transmission, thereby allowing communication of certain data back to the headend (i.e., advertiser terminal). (Col. 6, Ln. 37-42;

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Col. 8, Ln. 4-40; Col. 11, Ln. 27-39). Moreover, the system also inherently expands the transmitted data because it can be compressed before transmission. (as discussed under the rejection of claim 1). If the data is compressed, it must be decompressed (i.e., expanded) before it can be displayed. The remainder of the limitations are either inherent (such as the speaker) or were encompassed within claim 1. Accordingly, the combined systems of *Wilkins*, *Dedrick*, and *Wachob* disclose all limitations of claim 4.

Claim 6 is encompassed within the limitations of Claim 2. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 14 are combinations of limitations recited in Claims 1, 4 and 6. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 19 are combinations of limitations recited in Claims 1 and 7. Thus, it is analyzed and rejected as discussed therein.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM
August 29, 2006



JOHN MILLER
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